THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHI-KUEN SHU and BRIAN M. LAWRENCE

Appeal No. 95-0386
Application No. 07/854,122[1]

ON BRIEF

Before WINTERS, GRON and OWENS, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

---

[1] Application for patent filed March 19, 1992. According to appellants, this application is a continuation-in-part of Application No. 07/632,242, filed December 20, 1990, now abandoned.

This appeal was taken from the examiner's decision rejecting claims 1 through 24, which are all of the claims pending in the application.

Claim 1, which is illustrative of the subject matter on appeal, reads as follows:

1. A process for providing a flavorful and aromatic composition comprising the steps of:

(a) providing a first component in the form of at least one non-sulfur containing amino acid, non-sulfur containing amino acid analog and/or degradation product thereof;

(b) providing a second component in the form of at least one sugar, sugar analog and/or degradation product thereof;

(c) forming a mixture of the first component and the second component whereby the molar ratio of the first component to the second component ranges from about 1:1 to about 60:1; and

(d) subjecting the mixture of step (c) to heat treatment in a pressure controlled environment under conditions sufficient to form the flavorful and aromatic composition.

In rejecting the appealed claims under 35 U.S.C. § 103, the examiner relies on the following reference:

Wu et al. (Wu)	Re. 32,095	Mar. 25, 1986

In the Examiner's Answer (Paper No. 15), the examiner presented the following grounds of rejection: (1) claims

1 through 24 under 35 U.S.C. § 112, first paragraph, as based on a non-enabling disclosure; (2) claims 1 through 24 under 35 U.S.C. § 112, second paragraph, as indefinite; and (3) claims 1 through 24 under 35 U.S.C. § 103 as unpatentable over Wu. However, in the Supplemental Examiner's Answer (Paper No. 17), the examiner does not repeat or refer to the rejection of claims 1 through 24 under 35 U.S.C. § 112, second paragraph, as indefinite. See particularly the Supplemental Examiner's Answer, pages 1 and 2, summarizing the issues and the grounds of rejection remaining on appeal. There, the examiner refers to the rejection of all the appealed claims under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 103, but does not refer to the rejection under 35 U.S.C. § 112, second paragraph. These facts permit only one plausible interpretation, namely, that the examiner has dropped the rejection of claims 1 through 24 under 35 U.S.C. § 112, second paragraph, as indefinite. See Paperless Accounting v. Bay Area Rapid Transit System, 804 F.2d 659, 663, 231 USPQ 649, 652 (Fed. Cir. 1986).

Accordingly, the issues remaining for review are:

(1) whether the examiner erred in rejecting claims 1 through 24 under 35 U.S.C. § 112, first paragraph, as based on a non-enabling disclosure; and (2) whether the examiner erred in rejecting claims 1 through 24 under 35 U.S.C. § 103 as unpatentable over Wu.

DISCUSSION

In rejecting the appealed claims under 35 U.S.C. § 112, first paragraph, the examiner emphasizes the following claim recitations: (1) "alkyl and/or hydroxy alkyl group" in claims 5 and 13; and (2) "amino acid analog" in claims 1 and 10. Apparently, the examiner believes that these terms are "too broad" and that the claims should be limited to a more narrowly defined set of alkyl groups and amino acid analogs set forth in the supporting disclosure (Examiner's Answer, paragraph bridging pages 3 and 4; and page 7, first full paragraph).

The examiner's subjective belief that the claims are "too broad," however, is not supported by evidence or sound scientific reasoning. As stated in In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971):

> [I]t is incumbent upon the Patent Office, whenever a rejection on this basis [lack of enablement] is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement.

This the examiner has not done. In a nutshell, the examiner has not provided sufficient reasons or evidence, on this

record, which would serve to establish a prima facie case of non-enablement.

The rejection under 35 U.S.C. § 112, first paragraph, is reversed.

Turning to the rejection under 35 U.S.C. § 103, we find that Wu discloses a method for preparing reaction flavors for smoking compositions wherein a reducing sugar is combined with a source of ammonia in the presence of a trace amount of an amino acid
to form a reaction mixture which is heated to a temperature in the range of about 90EC to 105EC (Wu, column 3, lines 12 through 17 and lines 45 through 48). As stated by Wu, "[t]he weight ratio of sugar to amino acid will generally be in the range of
200-300:1 with a ratio of about 235-245:1 being preferred" (column 3, lines 61 through 63).

The claims on appeal require much greater amounts of amino acid compared with the amounts disclosed by Wu. This can be seen from a review of independent claims 1, 10, and 18, step (c) of each claim. Simply stated, the differences between the subject matter sought to be patented and the prior

art are substantial. On this record, the examiner has not explained how Wu's disclosure would have led a person having ordinary skill from "here to there," i.e., from the prior art process using trace amounts of amino acid to the claimed process using much greater amounts of amino acid.

The rejection under 35 U.S.C. § 103 is reversed.

In an effort to meet the molar ratio limitations recited in step (c) of independent claims 1, 10, and 18, the examiner refers to the "BACKGROUND OF THE INVENTION" portion of Wu, column 2, lines 3 through 17. There, Wu refers to U.S. Patent No. 3,920,026, issued November 18, 1975, to Warfield et al. (Warfield). As correctly pointed out by appellants, however, the examiner has not set forth a ground of rejection of any claim or claims based on Warfield (Reply Brief, page 4, first full paragraph).

Accordingly, we remand this application with instructions that the examiner step back and reevaluate the patentability of claims 1 through 24 in light of U.S. Patent No. 3,920,026 (Warfield). The examiner should engage in a claim-by-claim analysis. If the examiner believes that any claim or claims are unpatentable over Warfield, the examiner should set forth

an appropriate prior art rejection and provide appellants with an opportunity to respond.

For the reasons set forth in the body of this opinion, we reverse the examiner's prior art and non-prior art rejections. We remand this application to the examiner with instructions to reevaluate the patentability of claims 1 through 24 in light of Warfield.

This application, by virtue of its “special” status, requires immediate action. See the Manual of Patent Examining Procedure, § 708.01(d). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case.

REVERSED AND REMANDED

SHERMAN D. WINTERS Administrative Patent Judge	)	
TEDDY S. GRON Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
TERRY J. OWENS	)	

Administrative Patent Judge)

clm

Appeal No. 95-0386
Application No. 07/854,122

August J. Burschke
R.J. Reynolds Tobacco Co.
P.O. Box 1487
Winston-Salem, NC 27102